

**REMARKS****Summary of the Office Action**

Claims 1-4 and 6-12 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Kim (U.S. Patent No. 6,646,965) (hereinafter "Kim").

Claim 5 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Kim in view of Yonemitsu et al. (U.S. Patent No. 5,592,450) (hereinafter "Yonemitsu").

Method claim 11 is allegedly "drawn to the method of using the corresponding apparatus claimed in claim 8." Therefore, method claim 11 allegedly "corresponds to apparatus claim 8 and is rejected for the same reasons of anticipation as used above."

Claims 12 and 13 allegedly "have limitations similar to those treated in the above rejection, and are met by the reference as discussed above."

**Summary of the Response to the Office Action**

Applicants have amended claims 1-13 to differently describe embodiments of the disclosure of the instant application's specification and/or to improve the form of the claims. Accordingly, claims 1-13 remain pending for consideration.

**Rejections under 35 U.S.C. §§ 102(e) and 103(a) and Statement of the Substance of Examiner Interview**

Claims 1-4 and 6-12 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Kim. Claim 5 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Kim in view of Yonemitsu. Method claim 11 is allegedly "drawn to the method of using the corresponding apparatus claimed in claim 8." Therefore, method claim 11 allegedly "corresponds to apparatus

claim 8 and is rejected for the same reasons of anticipation as used above.” Claims 12 and 13 allegedly “have limitations similar to those treated in the above rejection, and are met by the reference as discussed above.”

Applicants have amended each of claims 1-13 to differently describe embodiments of the disclosure of the instant application’s specification and/or to improve the form of the claims in accordance with approaches described in a telephone interview with Examiner Kim K. Chu on May 18, 2007, as summarized in detail below. To the extent that these rejections might be deemed to still apply to the claims as newly-amended, they are respectfully traversed for at least the following reasons.

Examiner Kim K. Chu is thanked for the courtesies extended to Applicants’ undersigned representative in a telephone interview conducted on May 18, 2007. In this interview, Applicants’ undersigned representative explained particular technical distinctions regarding how the applied Kim reference does not anticipate the features of independent claim 1 of the instant application.

For example, Applicants’ undersigned representative explained how in current times there are many types of recording apparatuses in this technical field and that each of these types of recording apparatuses can differ in their recording parameters. Applicants’ undersigned representative explained that an important feature of the instant application’s claims is that a recording medium can be recorded onto by a variety of these different types of recording apparatuses in an optimal manner.

Applicants’ undersigned representative explained that this feature is achieved by recording in advance on a recording medium “identification information” and “recording

parameter information,” as described, for example in independent claim 1 of the instant application. Applicants’ undersigned representative explained that when a disk is mounted in a recording apparatus, the appropriate identification information can be read from the recording medium by the recording apparatus and the optimum recording parameter information for that particular recording apparatus is thus selected for optimizing a recording state of the information recording apparatus specified by the identification information.

Applicants’ undersigned representative referred the Examiner, for example, to Fig. 3 of the instant application that illustrates a plurality of sets of drive identification information and corresponding recording parameter information. Applicants’ undersigned representative explained how the appropriate set of identification information/recording parameter information would be selected based on the type of recording apparatus currently being utilized to record onto the recording medium.

The Examiner expressed an understanding of the differences between such an arrangement and the disclosure of the newly-applied Kim reference. However, the Examiner noted that he interprets the current “identifying one of the plurality of different information recording apparatuses” language in claim 1, for example, as meaning that only one type of information recording apparatus is identified and this is similar to prior art arrangements where a disc is associated with one type of recording apparatus.

In reference to Fig. 3 of the instant application, for example, the Examiner agreed that a feature of “wherein a plurality of sets of identification information and corresponding recording parameter information are recorded on the recording medium” is not disclosed or suggested by the currently applied Kim reference. Accordingly, Applicants have decided to implement this

particular language, as discussed during the interview, into each of independent claims 1, 8 and 11-13 of the instant application. Accordingly, at least in light of the Examiner's specific indication that Kim does not teach these features (see the Examiner interview summary form that was issued at the conclusion of the May 18, 2007 telephone interview), Applicants respectfully submit that the rejection of the claims based on Kim should now be withdrawn for at least the foregoing reasons.

On the interview summary form, the Examiner noted that he also suggests amending claim 1, line 5 to delete "one of the." After reading this indication on the interview summary form, Applicants' undersigned representative left a follow-up telephone message with the Examiner to indicate that such a deletion of "one of the" on its own would not result in a clearly-worded claim. As a result, Applicants' undersigned representative suggested if this change was to be made that it instead read "identification information for identifying ~~one of the~~ from a plurality of different information recording apparatuses, ~~the~~ an identified information recording apparatus for recording..."

The Examiner returned Applicants' undersigned representative's telephone message with a responsive telephone message on Monday, May 21, 2007 and indicated his agreement with the revised language. Accordingly, Applicants have decided to also implement this particular language, as previously presented to the Examiner as discussed above, into each of independent claims 1, 8 and 11-13 of the instant application.

Finally, before closing the conversation in the May 18, 2007 telephone interview, the Examiner noted that he would prefer that we amend each instance of "recording medium" in the claims to read "optical recording medium." Applicants' undersigned representative traversed

such a recommendation as not being consistent with our usual prosecution approach for recording medium claims. However, the Examiner indicated that we should ask Applicants to implement this change in order to make his examination search range narrower.

In other words, the Examiner mentioned that if such an amendment is not made, he will need to search other types of recording mediums, not only “optical” recording mediums, for the newly-proposed features. The Examiner also mentioned that if “optical” is not added to the claims, the application might possibly be moved to another Examining group.

Applicants’ undersigned representative responded that such an assertion might be difficult for Applicants to understand because multiple Office Actions have issued to date in this application by the same Examiner and the “recording medium” language has been in the claims since the original filing. The Examiner responded that the recent amendments, including the newly-proposed amendments, might require such a change.

Accordingly, in light of the Examiner’s request in this regard, Applicants have agreed to add “optical” to each instance of “recording medium” in the claims of the instant application.

With regard to the above-discussed amendments to independent claim 1 of the instant application, Applicants note that similar features have also been added to the remaining independent claims 8 and 11-13. Accordingly, Applicants respectfully submit that newly-amended independent claims 8 and 11-13 are also in condition for allowance for similar reasons as set forth above with regard to newly-amended independent claim 1.

Accordingly, Applicants respectfully assert that the rejections under 35 U.S.C. §§ 102(e) and 103(a) should be withdrawn because Kim does not teach or suggest each feature of independent claims 1, 8 and 11-13, as amended. As pointed out in MPEP § 2131, “[t]o anticipate

a claim, the reference must teach every element of the claim." Thus, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. v. Union Oil Co. Of California, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987)." Similarly, MPEP § 2143.03 instructs that "[t]o establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 409 F.2d 981, 180 USPQ 580 (CCPA 1974)."

Furthermore, Applicants respectfully assert that dependent claims 2-7 and 9-10 are allowable at least because of their dependence from claim 1 or 8, and the reasons set forth above. Moreover, Applicants respectfully submit that the additionally applied reference to Yonemitsu, with respect to claim 5, does not cure the deficiencies discussed above with regard to Kim.

### **CONCLUSION**

In view of the foregoing discussion, Applicants respectfully request the entry of the amendments to place the application in clear condition for allowance or, in the alternative, in better form for appeal. Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicants' undersigned representative to expedite prosecution. A favorable action is awaited.

**EXCEPT** for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. § 1.16 and 1.17 which may be required, including

any required extension of time fees, or credit any overpayment to Deposit Account No. 50-0573.

This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

**DRINKER BIDDLE & REATH LLP**

Dated: June 6, 2007

By:

A handwritten signature in black ink, appearing to read "Paul A. Fournier", written over a horizontal line.

Paul A. Fournier

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